

REMARKS

Claims Previously Present

Claims 1-7 were originally presented. Applicant originally notes that the Examiner acted upon only claims 1-5 of the present application. However, a Preliminary Amendment was filed on November 28, 2001, wherein claims 1-5 were amended, and wherein new claims 6-7 were added. Although the Examiner apparently did not act on these claims, resubmission of these claims is not included in the present Amendment as new claims 8-18 have been submitted to replace claims 1-7. Applicant merely mentions this to ensure that the record is clear in connection with the present application.

Claims Currently Present

By the present Amendment, claims 1-7 have been cancelled without prejudice or disclaimer of the subject matter contained therein. In their place, new claims 8-18 have been added. As these new claims include the subject matter previously present in independent claim 1, these claims are merely directed to more specific aspects of the present application, and are not directed to different inventions, different from that previously examined by the Examiner. Claims 8, 14 and 17 are independent.

Preferred Embodiments of the Present Application

The present application, in a first preferred embodiment as shown in Fig. 1 for example, is directed to a remote controlled inspection device for an annular combustion chamber, such as chamber 5 as shown in Fig. 1 for example. The chamber includes an inner internal wall portion 9 and an outer internal wall portion 11. The inspection device includes a

carrying framework including a lower frame 23 and an upper frame 24. The frames include wheels 29 for moving the carrying framework along the inner internal wall portion and outer internal wall portion of the annular combustion chamber, such that the frames rest upon the internal walls. As shown in Fig. 1 and as described in paragraphs [0016] through [0018], the two frames of the carrying framework straddle between the inner internal wall portion and outer internal wall portion of the annular chamber so that the wheels may carry the framework along these portions.

The wheels therefore allow the frame to move in a circumference direction of the annular combustion chamber. Translational motion on a translational rail 31, rotational motion of a shank 39, and pivoting motion of an articulation fork 37, combined with the motion of the carrying framework in the circumference direction of the annular combustion chamber allow inspection of the walls 9 and 11 surrounding the entire ring-shaped annular space 10.

Prior Art Rejections

The Examiner has rejected claims 1, 2 and 5 under 35 U.S.C. §103 as being unpatentable over Dailey. This rejection has been rendered moot in view of the cancellation of the claims. Further, this rejection is inapplicable to new claims 8-13 for at least the following reasons.

Claim 8

Independent claim 8 of the present application has been written to clarify that the remote controlled inspection device is for an annular combustion chamber of a gas turbine

including an inner internal wall portion and an outer internal wall portion. The carrying framework has been clarified to indicate that the carrying framework includes a lower frame and an upper frame, as well as a plurality of wheels for moving the carrying framework along the inner internal wall portion and outer internal wall portion of the annular combustion chamber. As such, the upper and lower frames of the carrying framework are restable upon the inner internal wall portion and outer internal wall portion of the annular combustion chamber.

Distinctions over the Dailey Reference

Dailey is directed to an apparatus with wheels on the bottom thereof, for traveling along a single portion of some type of structure or apparatus. To the contrary, the inspection device set forth in claim 8 is directed to a specifically designed device for an annular combustion chamber including inner internal wall portions and outer internal wall portions (a type of a ring-like structure, for example). The carrying framework of the device as set forth in claim 8 has been specifically designed to include **an upper and lower frame which are restable upon and which move along the inner internal wall portion and outer internal wall portion of the annular combustion chamber.** Such a device is therefore completely different from, and thus distinguishes from, the device shown in Dailey which includes no such specifically designed carrying framework.

Accordingly, Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of claim 8 of the present application, and all claims dependent thereon. With regard to the remaining claims, these claims are allowable for at least the reasons previously set forth regarding their corresponding independent claim, and for the additional limitations

present therein.

Additional Prior Art Rejections

The Examiner has rejected claims 3 and 4 under 35 U.S.C. §103 as being unpatentable over Dailey in view of Morrison et al. This rejection has been rendered moot in view of the cancellation of claims 3 and 4, and is further inapplicable to new claims 14 and 15 for at least the following reasons.

Independent Claims 14 and 17

Claim 14 is directed to a remote-controlled inspection device including, among other features, **a self-supporting** C-shaped rail, by which the carrying framework is capable of traveling in the annular combustion chamber. Such a C-shaped rail is supported by at least Fig. 3 of the present application, for example. With regard to claim 17, this claim is directed to a remote-controlled inspection device for an annular chamber, and includes a self-supporting articulated arm, on which a carrying framework is mounted. This is supported by at least Fig. 4 of the present application.

Prior Art Distinctions – Claim 14

The Examiner admits that the Dailey reference fails to teach or suggest a self-supporting C-shaped rail, as is now set forth in claim 14. The Examiner alleges that the prior art to Morrison et al. shows an inspection system capable of maneuvering over a curved surface for inspection purposes, alleges that it is substantially similar to the claimed C-shaped rail, and further alleges that it would have been obvious to use the teachings of the inspection

system in Morrison et al. for difficult access locations. Applicant respectfully traverses.

Initially, Applicant respectfully submits that even assuming *arguendo* that Morrison et al. could be combined with Dailey, which Applicant does not admit for the reasons which will be set forth hereafter, Morrison et al. would still fail to makeup for aforementioned deficiencies of Dailey. In Morrison et al., as alleged by the Examiner, the system is merely for maneuvering over curved surfaces for inspection purposes. The system of claims 14 includes a self-supporting C-shaped rail and thus does not need to go “over” curved surfaces. Thus, Morrison et al. would still fail to teach or suggest a self-supporting C-shaped rail as claimed in claim 14 of the present application, and thus would still fail to make up for the deficiencies of Dailey.

An example of a self-supporting C-shaped rail is supported by at least Fig. 3 of the present application, where it can be seen that such a C-shaped rail may be a telescopically extendable rail. More importantly, however, it is clear that the rail is self-supporting (therefore does not have to lean against combustion chamber walls nor maneuver over a curved surface as is the case in Morrison et al.). Such a self-supporting C-shaped rail is not taught or suggested by Morrison et al. and therefore, even assuming *arguendo* that Morrison et al. could be combined with Dailey, the alleged combination would still fail to teach or suggest such a feature as set forth in claim 14 of the present application. Accordingly, withdrawal of the Examiner’s rejection and allowance of claim 14 is respectfully requested.

Further, the Examiner has not supplied any evidence of the necessary motivation needed to lead one of ordinary skill in the art to combine the teachings of Dailey and Morrison et. al. Accordingly, absent such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicant directs the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable.

See Dembiczak 50 USPQ2d at 1617. **Broad conclusory statements standing alone are not "evidence".**

The Examiner has not alleged any motivation for combining Dailey and Morrison et. al. to reject claims 3 and 4. Thus, the Examiner as not presented any evidence which *is present in any of the references* and has merely been alleged by the Examiner based upon Applicant's invention, in hindsight. Such use of hindsight is clearly improper.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617.

Accordingly, Applicant respectfully submits that the claims are allowable for at least this additional reason.

Furthermore, the Examiner has not provided the **requisite evidence** to support the allegation that there is motivation to combine Dailey and Morrison et. al., so as to render obvious that which Applicant has described. The Examiner has not provided any showing of a suggestion, teaching or motivation to combine the prior art references to reject the claims in the present application, which is an essential component of an obviousness holding. The Examiner must explain the *reasons why* one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious (In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) the examiner can satisfy the burden of showing obviousness of the combination "only by showing *some objective teaching in the prior art or that knowledge generally available* to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Thus, the Examiner has not adequately provided a proper combination of Dailey and Morrison et. al. to render claim 14 obvious. In Dailey, clearly wheels are utilized to enable the device to transport a video camera along the surface. There would be clearly be no need, therefore, for any such **self-supporting** device and thus it would be difficult, if not impossible, for the Examiner to provide necessary motivation for combining such teachings with that of Dailey.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430

(Fed. Cir. 2002). Further, relying on obvious design choice as a reason for combining teachings of the various references is again not the proper standard for obviousness. *If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration* setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, Applicant respectfully challenges the Examiner's alleged motivation and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained.

Thus, withdrawal of the outstanding rejection is respectfully requested.

Prior Art Distinctions – Claim 17

Finally, with regard to claim 17, this claim is directed to an inspection device including a **self-supporting** articulated arm on which the framework for carrying the video camera is mounted. Such a self-supporting articulated arm is not taught or suggested by any of the prior art references, as admitted by the Examiner. Instead, the Examiner merely takes official notice with regard to such a limitation.

Applicant respectfully challenges the Examiner's taking of official notice. Further, Applicant respectfully requests the Examiner, if such a self-supporting articulated arm is found, to provide necessary motivation as to why one of ordinary skill in art would be led to modify the teachings of Dailey to include such a self-supporting articulated arm. In Dailey, clearly wheels are utilized to enable the device to transport a video camera along the surface. There would be clearly be no need, therefore, for any such self-supporting articulated arm and thus it would be difficult, if not impossible, for the Examiner to provide necessary motivation for combining such teachings with that of Dailey. Accordingly, withdrawal of the Examiner's

rejection and allowance of claim 17 is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the outstanding objections and rejections and allowance of each of claims 8-18 of the present application is respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$120.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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